



UNITED STATES PATENT AND TRADEMARK OFFICE

CU

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/714,066	11/13/2003	Zhengming Chen	6750-234-999	1403
20583	7590	06/07/2006	EXAMINER	
JONES DAY 222 EAST 41ST ST NEW YORK, NY 10017			SHAMEEM, GOLAM M	
			ART UNIT	PAPER NUMBER
			1626	

DATE MAILED: 06/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/714,066

Applicant(s)

CHEN, ZHENGMING

Examiner

Golam M. M. Shameem, Ph.D.

Art Unit

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 April 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-111 is/are pending in the application.
- 4a) Of the above claim(s) 13-20 and 33-111 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☒ Claim(s) 1-12 and 21-32 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Priority

This application claims benefit for domestic priority under 35 U.S.C. § 119(e) [to a provisional application 60/427,381 11/18/2002], is acknowledged.

Status of Claims

Claims 1-111 are currently pending in the application.

Receipt is acknowledged of amendment / response filed on April 14, 2006 and that has been entered.

Claims 13-20 and 33-111 are withdrawn from further consideration pursuant to 37 C.F.R. 1.142 (b) as being drawn to a non-elected subject matter.

Response to Election/Restriction

In response to the restriction requirement, Applicants have elected Group I, which includes claims 1-12 drawn to a compound of formula (Ia) and the elected species as set forth found in compound AFE at page 21, with traverse is acknowledged. The traversal is on the ground(s) that all the pending claims should be rejoined and examined with the elected Group I because there is no "serious burden" on the Examiner and therefore, a search and examination of the entire Markush group should be made for this application without a serious burden.

Applicant's arguments are fully considered and found partially persuasive and therefore, Examiner has agreed to modify the restriction requirements to include Group II (claims 21-32) to the elected invention of Group I. In response to Applicant's request for clarification for grouping of claim 85, the restriction requirements has been modified to include a new group with this claim as follows:

XI. Claim 85 drawn to a method for preparing a composition classified in class 514.

However, the Examiner respectfully disagrees with the Applicants other arguments because the products of Invention groups I-XI differ materially in structure and in element from each other and therefore, are capable of supporting their own patents. The invention groups I-XI are related to a set of structurally diverse and dissimilar compounds, compositions, method of preparation and their methods of uses (chemical structures, which are similar, are presumed to function similarly, whereas chemical structures that are not similar are not presumed to function similarly), which do not possess a substantial common core wherein a reference anticipating one would not necessarily render the other obvious and to search all the above groups in a single application would be an undue burden on the Examiner. Because of many classes and subclasses in each of the Group, a separate search considerations are involved, which would impose a serious burden on the Examiner to perform a complete search of the defined areas if unrestricted. Also the fields of search are not coextensive. The wide disparity among the groups requires that many divergent fields must be searched, including all classes and subclasses of U.S. and foreign patents as well as journals and publications. Moreover, the Examiner must perform a commercial database search on the subject matter of each group in addition to a paper search, which is quite burdensome to the Examiner. Nevertheless, Examiner may reconsider to rejoin method of use claims commensurate in scope with the product claims when the case would be found in condition for allowance [provided those method claims are free from 35 U.S.C. §112 first (including written description, reach-through claim language and/or scope-enablement issues) and second paragraphs]. For these reasons, Applicant's arguments are found unpersuasive and, therefore, the requirement for restriction and election of species is still deemed proper.

Applicants preserve their right to file a divisional on the non-elected subject matter.

As set forth in the restriction requirement and an election of a single compound (or set of compounds), the invention will encompass all compounds that fall within the scope of the claim is as follows:

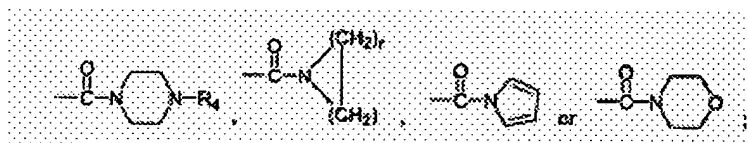
A compound having the formula as shown in claim 1 wherein:

Ar₁ is as claimed,

Ar₂ is as claimed,

G is as defined,

R₁ is as claimed except heterocyclic ring i.e. R₁ cannot be



R₂ is as claimed,

R₃ is as claimed and p, q and m are as defined.

As a result of the election and the corresponding scope of the compound identified, claims 13-20 and 33-111 and the remaining subject matter of claims 1-12 and 21-32 are withdrawn from further consideration pursuant to 37 CFR 1.142 (b) as being drawn to non-elected inventions. The withdrawn subject matter of claims 13-20 and 33-111 is properly restricted as it differs materially in structure and in element from the elected subject matter supra so as to be patentably distinct there from.

Objections

Claims 1-12 and 21-32 are objected to for containing non-elected subject matter. The claims should be amended to exclude non-elected subject matter and within the scope of elected compound.

Telephone Inquiry

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Golam Shameem, Ph.D. whose telephone number is (571) 272-0706. The examiner can normally be reached on Monday-Thursday from 6:30 AM - 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph McKane, can be reached at (571) 272-0699. The Unofficial fax phone number for this Group is (703) 308-7921. The Official fax phone numbers for this Group are (571)-273-8300. When filing a FAX in Technology Center 1600, please indicate in the Header (upper right) "Official" for papers that are to be entered into the file, and "Unofficial" for draft documents and other communications with the PTO that are not for entry into the file of the application. This will expedite processing of your papers.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [joseph.mckane@uspto.gov]. All Internet e-mail communications will be made of record in the application file. PTO employees will not communicate with applicant via Internet e-mail where sensitive data will be exchanged or where there exists a possibility that sensitive data could be identified unless there is of record an express waiver of the confidentiality requirements under 35 U.S.C. 122 by the applicant. See the Interim Internet Usage Policy

Art Unit: 1626

published by the Patent and Trademark Office Official Gazette on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist, whose telephone number is (571) 272-1600.

Golam M M Shameem, Ph.D.
Primary Examiner
Art Unit 1626
Technology Center 1600

A handwritten signature in black ink, reading "G. M. Shameem". The signature is stylized with a large, sweeping initial "G" and "M".

GOLAM M. M. SHAMEEM, PH.D
PRIMARY EXAMINER

May 25, 2006